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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,487	05/10/2001	Robert M. Best	493-25-3	7727
996	7590	09/07/2004	EXAMINER	
GRAYBEAL, JACKSON, HALEY LLP			MOSSER, ROBERT E	
155 - 108TH AVENUE NE			ART UNIT	
SUITE 350			PAPER NUMBER	
BELLEVUE, WA 98004-5901			3714	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

4W

Office Action Summary

Application No.

09/853,487

Applicant(s)

BEST, ROBERT M.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 20th, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 375-512 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 374-512 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION



In response to the amendment received May 20th, 2004.

**The previously indicated allowable subject matter is withdrawn based on the
rejections below.**

Claims 375 – 512 are pending.

This Action is non-final.



Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **410, 419, 479, 506** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically the claimed "finger of a human operator" is phenomenon of nature and as such does not fall under the umbrella of patentable subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **375-408, 413, 414, 416, 417, 421-444, 446-457, 459-464, 467-477, 481-504, and 508-511** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimoto et al (US 6,238,291) in view of Miyamoto et al (US 6,139,433) in further view of Sawano et al (US 6,544,126) herein referred to as 291', 433' and 126' respectively.

Regarding at least claims **375-408, 413, 414, 416, 417, 421-444, 446-457, 459-464, 467-477, 481-504, and 508-511**, Fujimoto (291') teaches a first game apparatus (100) such as the Nintendo 64 (Col 2:23-30) containing a first processor (11) and a first graphical processor (16) connected to a second separately housed portable game system or discrete display device (400) such as the Nintendo Gameboy (Col 2:23-30) containing a second processor (431), a second graphics co-processor (433) and a discrete LCD display device (401). Where the first and second devices transfer data (understood to encompass variables, instructions, graphics, other digital transfers, ect) required for development of the game via a wireless or wire connection (Col 2:66-3:9 & 3:24-27). The 291' patent teaches the use of displaying separate game related info on a public display screen (600) and the private handheld screen (401) in the game of

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Mahjong, however the 291' patent is silent regarding the incorporation of 3-dimensional textured polygon characters defined by a plurality of body parts.

In a related application however Miyamoto et al (433') teaches the ability for the Nintendo 64 (Figure 1) to handle 3-d graphics, including multiple points of view (adjustable camera angle), characters composed of a plurality of body parts, the display of these characters (Figures 4, 23, 27 33 & Abstract). It would have been obvious to incorporate the 3-d capabilities of the Nintendo 64 game system as demonstrated in the Miyamoto reference (433') in the system of Fujimoto (291') in order to off the user greater visual detail and maintain the users interest in the gaming device.

In an additional related application Sawano et al (126') teaches the ability of the Nintendo Gameboy to process 3-D graphics (6:32-49) and the second game machine processing information as distributed to it by the primary game machine (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized the 3-d capabilities of the Nintendo Gameboy in the system of 433'/291' in order to allow the player to interface with a 3-d game as shown on an external viewing device such as a TV with a person controller with a handheld 3-d display to allow the player complete actions in a game without immediately revealing those actions to other players as taught by 291' (Col 1:41-45)

Regarding the limitation of a plurality of 3-dimensional articulated body parts and similar language directed to a 3-dimensional world and other graphic display features in claims **376-380, 389-391, 393-397, 405-408, 421, 424-426, 430, 432-438, 446-456, 459, 460, 463, 464, 467, 472-477, 494-499, 502-504, 508-510, and 511** the 291'

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reference teaches displaying either a portion or a subset of a game presented on a larger display such as a TV (ABS) including the use of scaling (fig 9) and the use of multiple discrete display units (Fig 2, 5) including multiple LCD display units (401). The 433' reference teaches the manipulation of camera angle through button (ABS) the determined direction of movement or various other criteria (figure 24) in addition to the controllable and articulated body parts of figure 11. When the 291' and the 433 reference are then taken in combination with the 126' reference they provide a 3-d point of view controller for displaying game characters, worlds and objects like that as shown in figure 27 of 433' in the claimed partial or full scaled depiction with the claimed detail and possible multiple camera angles simultaneously between the TV and multiple discrete handheld display unit.

Regarding the limitations of a first through forth program instructions, various predetermined conditions, and/or based on user interaction with a game as found in at least claims **375-388, 392, 398, 399, 313, 414, 416-417, 421, 422, 424, 427, 430-435, 439-442, 457, 458, 460-462, 471-477, 481, and 484-504** the use of these well known programming conventions used to effect data and hardware functionalities in computing systems responsive to a user's interaction, are inherent feature of computer operation and required for the processing of and software program type data on a hardware system as demonstrated by at least 126' figure 8, 291" figure 9, and 433' figure 11. Alterations in use of the above conventions based on the specific functionality and/or desired functionality of are considered to be a matter of design choice wherein no stated problem is solved or unexpected result obtained in the utilization of the previously well

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known methods that has not been either shown by the references above and/or known programming conventions including the use of conditional statements, user inputs, and programs previously.

Regarding the limitation of storing a second game program in a removable cartridge as found in at least claims **400, 429, 444** and **260**. The 291' reference teaches the use of cartridges (500, 300) containing semi-conductor memory (Col 5:33-37) for the storage of the second program. It would have been obvious to one of ordinary skill in the art at the time of invention to utilize removable cartridges in the device of as 291'/433'/126' in order to offer a game medium that is safe from scratches and hence more resistant to degradation.

Regarding the limitation of the memory medium is an optically encoded disk as found in claims **401-404, 428, 442, 468**, and **259**. The 126' reference teaches the use of an optically encoded disk (46). It would have been obvious to of ordinary skill in the art at the time of invention to utilize optically encoded disks as shown in 126' in the invention of 291'/433'/126' due to their easy of manufacture and low cost.

Regarding the limitation of a wireless or partly wireless transmission link as found in at least claims **423, 470** and **269**. The 291' reference teaches the use of wireless transmission (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to utilize a wireless or partly wireless transmission link as demonstrated by 291' in the device of as 291'/433'/126' in order to give players greater freedom movement and/or allow the secondary game device to directly communicate with each other.

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Regarding at least claims **482** and **483** the 291'/760'/028' system is silent as to the incorporation of preview and replay features. However it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a replay feature in order to remind himself or herself of the story line or alternatively, a preview function in order to judge a possible consequence to an action in a game prior to taking the action.

Claims **409-412**, **415**, **418-420**, **445**, **458**, **465-466**, **478-480**, **505-507**, and **512**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimoto et al (US 6,238,291) in view of Miyamoto et al (US 6,139,433) in further view of Sawano et al (US 6,544,126) in yet further view of applicant's admitted prior art.

291'/433'/126' are silent regarding the limitation incorporating the use of a touch screen in at least claims **409-412**, **415**, **418-420**, **445**, **458**, **465-466**, **478-480**, **505-507**, and **512**, however this feature is presented by applicant in the background of invention section of their specification of their application as admitted prior art.

It would have been obvious to one of ordinary skill in the art the time of invention to have incorporated a touch screen interface into the invention of 291'/433'/126' in order to increase the input flexibility through allowing the inclusion of "soft" buttons.

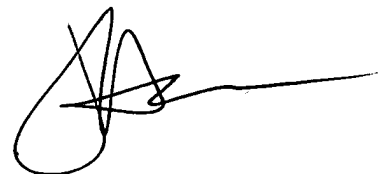
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

A handwritten signature in black ink, appearing to read 'J. Harrison', with a long horizontal line extending to the right.

JESSICA HARRISON
PRIMARY EXAMINER